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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,169	02/05/2002	Daniel E. Rudman	5197-000001	8055

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/068,169	RUDMAN, DANIEL E.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 6-11, 14, 17-18, 20 and 23-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Allen (US 2003/0036974 A1).

Allen teaches a method and system for preview, selection, retrieval and reproduction at remote location of titles on selected media, comprising:

Claim 1. Permitting a consumers to select a specific title for reproduction [0025]; creating a consumer profile database [0013]; providing media suppliers with information on particular consumer groups [0013] for displaying to said consumers a predetermined advertisement based on said information, thereby inherently indicating providing opportunity to the media suppliers to obtain revenue. Information as to *total choice and total control* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Claim 4. Providing the consumers with advertising based on consumers profile inherently indicates providing the consumers with *media that is of possible interest to the consumer* [0013]; and updating (expanding) the consumer's profile of preferred media [0012].

Claim 6. Updating (storing) the consumer's profile of preferred media in response to predetermined consumer interactions with the system [0012].

Claim 7. Storing in a database most current statistical information; and managing reporting tasks [0030].

Claim 8. Storing in a database most current statistical information; and managing reporting tasks [0030].

Claim 9. Use a consumer profile database as a market data to determine which consumer groups are previewing a particular type of title [0013].

Claim 10. Providing the consumers with advertising based on consumers profile inherently indicates *providing the consumers with information about the products the consumer may be interested in purchasing* [0013].

Claim 11. Providing accounting system for maintaining debit and credit activity between title providers and remote locations (personal consumer devices) inherently indicates *providing the consumer with a means for purchasing the products* [0014].

Claim 14. Selecting a title and purchasing the item [0013]; [0069].

Claim 17. Said media as in claim 1. Information as to *any multimedia product* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 18. Transmitting the copy of media to a personal media device from a media services server over a communication network [0025]. Information as to *fully* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999)*

Claim 20. Transmitting the copy of media (segment) to a personal media device after said media (segment) has been stored in the local data base on the personal media device [0066]. Information as to *full* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999)*

Claim 23. Permitting a consumers to select a specific title for reproduction [0025]; creating a consumer profile database [0013]; providing media suppliers with information on particular consumer groups [0013] for displaying to said consumers a predetermined advertisement based on said information, thereby inherently indicating providing opportunity to the media suppliers to obtain revenue. Information as to *total choice, total control and operational efficiency opportunities* is non-functional language and given no patentable weight.

Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 24. Said system comprising: a central host server (20); a storage facility (30); a remote server (70); statistical counter database; a storage facility (60); an advertising/promotion database (363); a master customer database (365); a consumer interface terminal (160) and a customer personal device [0030]; [0034]; [0078].

Claim 25. Said system adapted to provide targeting and reporting tasks [0013]; [0030].

Claim 26. Said system including means for generating reports from the databases or data warehouses [0030].

Claim 27. Said system, including a consumer interface adapted to transmit to and receive data from the remote server, and the personal media device adapted to reproduce the media [0030]; [0034].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Goldhaber et al. (US 5,855,008) (hereinafter Goldhaber).

Claim 2. Allen teaches all the limitations of claim 2, except specifically teaching that the *consumers do not pay fee to use the system.*

Goldhaber teaches a method and system for distributing advertising and other information over the Internet, wherein a mass media receives its revenue from advertisers (C. 1, L. 64-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include that *the consumers do not pay fee to use the system*, as disclosed in Goldhaber, because it would stimulate the consumers to use said system.

Claim 3. Goldhaber teaches said method and system for distributing advertising and other information over the Internet, wherein a mass media charges audience members for content delivery (C. 1, L. 61-62). The motivation to combine Allen with Goldhaber would be to provide funds for business to operate.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen.

Claim 5. Allen teaches all the limitations of claim 5, except specifically teaching that the personal media device *is operable to function when disconnected from the system and to continue in a limited manner.*

Official notice is taken that it is well known to use a personal computer to access files, which were downloaded from the Internet, after said personal computer is disconnected from the Internet, thereby obviously indicating *limited* use of the computer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include that the personal media device *is operable to function when disconnected from the system and to continue in a limited manner,* because it would allow consumers to playback music files, which they downloaded from a mass media server.

Claims 12-13, 15 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Spagna et al. (US 5,855,008) (hereinafter Spagna).

Claim 12. Allen teaches all the limitations of claim 12, including that the consumer selects media titles [0013], except specifically teaching *that said selection is based on metadata.*

Spagna teaches a method and system for forming a data table in memory of an end user system, wherein a consumer is accesses a content promotions Web site, and selects a title to download, and wherein the selection of metadata containing promotional and descriptive information about a song of album is provided [0885].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include *selecting media titles based on metadata,* as disclosed in Spagna, because it would provide the consumer comprehensive information about the title, thereby allowing the consumer to make a right choice of the title.

Claim 13. Providing selection of promotional and descriptive information about a song of album is provided (Spagna; [0885]). The motivation to combine Allen with Spagna would be: to provide the consumer comprehensive information about the title, thereby allowing the consumer to make a right choice of the title. Information as to *news or events* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Allen in view of Spagna would be performed the same regardless of the content of said descriptive information.

Claim 15. Providing the consumer a tool for managing his/her digital content library, including editing and playing of collection of songs (Spagna; [0997]). The motivation to combine Allen with Spagna would be: ability to alter private collection, thereby stimulating consumers to use the system.

Claim 21. Said method, wherein the media supplier provides content, metadata and digital rights information (Spagna; [0885]; [0059]; [0204]). The motivation to combine Allen with Spagna would be: educating consumers regarding intellectual property rights, thereby decreasing unauthorized copying of copyrighted materials.

Claim 22. Said method, wherein the media can be protected by a digital rights management system (Spagna; [0059]; [0204]). The motivation to combine Allen with Spagna would be: decreasing unauthorized copying of copyrighted materials.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Lesandrini et al. (US 2003/0036944 A1) (hereinafter Lesandrini).

Claim 16. Allen teaches all the limitations of claim 16, except specifically teaching *providing the consumer with a message board that is operable to allow the consumer to communicate with other consumers that are on the system and further allow the consumer to transmit personally suggested media to fellow users on the system.*

Lesandrini teaches a method and system for performing a business research over the Internet, wherein a message board, chat rooms or forums are provided so that consumers can recommend commercials to others [0115]; [0144].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include *providing the consumer with a message board that is operable to allow the consumer to communicate with other consumers that are on the system and further allow the consumer to transmit personally suggested media to fellow users on the system,* as disclosed in Lesandrini, because consumer

opinion about a product is not influenced by the product manufacturers, and providing such independent reviews would stimulate other consumers to purchase the product.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Internet Print-out http://web.archive.org/ (Document).

Claim 19. Allen teaches all the limitations of claim 19, except specifically teaching that said media is transmitted to a personal media device *from the combined resources* of a personal media services server and from a partial copy of the media locally stored on the personal media device.

Document, which is an archived copy of a November 10, 1999 of Barnes and Noble bookstore web page, discloses a *combined content*, which is simultaneously transmitted from various sources. Page 2 (see examiner's numeration at the bottom of a page) shows the information source for Barns and Noble bookstore content; page 3 shows the information source for AOL Instant Messenger service; and page 4 shows the information source for Textbook.com service. As to *locally stored on the personal media device*, use of the Microsoft Internet Explorer Browser includes storing a web page content in the Temporary Internet Folder.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include that said media is transmitted to a personal media device *from the combined resources,* as disclosed in Document, because it would provide the consumer with various types of media, thereby satisfying consumers with various personal media preferences.

Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen in view of Hewitt et al. (US 2001/0034219 A1) (hereinafter Hewitt).

Claim 28. Allen teaches all the limitations of claim 28, except that *the interface between the personal media services server and a personal media device is a wireless network.*

Hewitt teaches a method and system for providing information to a radio appliance, wherein said radio appliance is adapted to be in wireless communication with the Internet or a personal computer connected to the Internet [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include that the interface between the personal media services server and a personal media device is a wireless network, as disclosed in Hewitt, because it would allow mobile users to use this system, thereby increasing amount of customers and revenue collected.

Claim 29. Allen teaches all the limitations of claim 29, except specifically teaching that *the interface between the personal media services server and a personal media device is the Internet.*

Hewitt teaches a method and system for providing information to a radio appliance, wherein said radio appliance is adapted to be in wireless communication with the Internet [0020].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include that the interface between the personal media services server and a personal media device is the Internet, as disclosed in Hewitt, because the Internet is affordable existing communication means, and use of the Internet would allow to save funds.

Claim 30. Allen teaches all the limitations of claim 30, except specifically teaching that said customer database (365), which is in communication with a central host server, a subscriber database.

Hewitt teaches a method and system for providing information to a radio appliance, including a subscriber database, which is accessible over the Internet [0021]; [0024].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include a subscriber database, as disclosed in Hewitt, because use of a subscription would allow to generate funds.

Claim 31. Allen teaches said system comprising: advertising/promotion database (363); statistical counter database; customer database (365); a storage facility (30); a consumer media device; a central host server; a remote server; a consumer media device operable to exchange data from the remote server, and targeting and reporting means [0030]; [0034]; [0078]. Allen does not specifically teach that said customer database (365), which is in communication with a central host server, a subscriber database.

Hewitt teaches a method and system for providing information to a radio appliance, including a subscriber database, which is accessible over the Internet [0021]; [0024].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allen to include a subscriber database, as disclosed in Hewitt, because use of a subscription would allow to generate funds. Information as to *whereby consumers provide behavioral and preferential feedback to the tracking and subscriber databases which in turn updates the data warehouse* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 31 are disclosed in Allen in view of Hewitt as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The following foreign patent is cited to show the best foreign art found by the examiner:

EP1162840A2 to Wilson, disclosing a method of delivery targeted content to subscribers using communication media.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor N. Borissov
Paten Examiner
Art Unit 3629

8/02/04

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